

REMARKS

In the April 8, 2005 Office Action, the Examiner:

- Rejected claims 2-5 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention;
- Rejected claims 1, 3, and 5 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,855,144 (“*Parada*”); and
- Rejected claims 2 and 4 under 35 U.S.C. § 103(a) as being unpatentable over *Parada* in view of in view of U.S. Patent No. 6,796,202 (“*Takai*”).

Applicant amends claims 1-5 and adds claim 6-13. No new matter has been added. The pending claims are claims 1-13.

Claim Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 2-5 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has incorporated the Examiner’s suggestions in the amendments to the claims and has amended the claims to comply with 35 U.S.C. § 112, second paragraph. Therefore, Applicant respectfully requests withdrawal of this rejection.

Claim Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1, 3, and 5 under 35 U.S.C. § 102 as being anticipated by *Parada*. Applicant, however, respectfully traverses this rejection, in light of the amendments.

For a proper showing that these claims are anticipated by *Parada*, all elements of the rejected claim must be disclosed in the cited reference.

Examiner states that *Parada* discloses “a remote control button assembly built in a steering wheel including at least more than three front buttons 22 on a front surface of a steering wheel, and at least one side button 18 provided in a lower portion of one lateral surface of an engaging region in which the front buttons are provided” and “[t]he width of the pressing portion of the side button is the same as that of the pressing portion of the front button.” However, Applicant has amended independent claim 1 to further include limitations that recite the location of the front buttons and structure of the side buttons, which is an

important aspect of the present invention. In *Parada*, the front buttons are structured so that they are pressed in a direction perpendicular to the direction that the side buttons are pressed. In other words, the front buttons are structured to be pressed in a downward direction from the front surface of the steering wheel (a direction perpendicular to the plane of the surface of the steering wheel) and the side buttons are structured to be pressed in a direction parallel to the plane of the surface of the steering wheel. On the other hand, in the present invention, the front and side buttons are operative the same direction. They are both structured to be pressed in the downward direction from the front surface of the steering wheel (the direction perpendicular to the plane of the surface of the steering wheel).

In light of the above, it is respectfully submitted that- *Parada* does not disclose, teach, or suggest all of the limitations of independent claims 1. Accordingly, *Parada* cannot anticipate any of the claims that depend there from as well. Furthermore, because claims 3 and 5 depend from independent claim 1, *Parada* also does not anticipate claims 3 or 5. Applicant respectfully requests withdrawal of this rejection. Additionally, Applicant had added claim 7, which Applicant believes to be patentable over the cited references for the same reasons.

Claim Rejections Under 35 U.S.C. § 103

Examiner rejected claims 2 and 4 under 35 U.S.C. § 103(a) as being unpatentable over *Parada* in view of in view of *Takai*. Applicant, however, respectfully traverses this rejection, in light of the amendments.

To establish a prima facie case of obviousness, three basic criteria must be met, namely:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) There must be a reasonable expectation of success; and
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

As previously stated, independent claim 1, the claim from which claims 2 and 4 depend, has been amended to further recite the location of the front buttons and structure of

the side buttons. In *Parada*, the front buttons are structured so that they are pressed in a direction perpendicular to the direction that the side buttons are pressed. *Parada* does not disclose front and side button that are pressed in the same direction.

As shown above, *Parada* does not disclose, teach or suggest front buttons and side buttons that are structured so that they are pressed in the same direction. *Takai* also does not disclose buttons that are structured so that they are pressed in the same direction.

Accordingly, the combination of *Parada* and *Takai* does not teach or suggest all the claim limitations. Therefore, claims 2 and 4 cannot be unpatentable over *Parada* in view of *Takai*, as the prior art references do not teach or suggest all of the claim limitations. For the above reasons, Applicant respectfully requests withdrawal of this rejection.


CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is now in a condition for allowance. However, should the Examiner believe that the claims are not in condition for allowance, the Applicant encourages the Examiner to call the undersigned attorney at (415) 442-1106 to set up an interview.

If there are any fees or credits due in connection with the filing of this Amendment, including any fees required for an Extension of Time under 37 C.F.R. Section 1.136, authorization is given to charge any necessary fees to our Deposit Account No. 50-0310 (order No. 060943-0053-US). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

Date: July 7, 2005


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